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Re: Application of: McGregor et al.
Serial No.: 09/832,767
Filed: April 11, 2001
For: System for Generating Revenue Using Electronic
Mail and Method for Its Use
Group Art Unit: 3622
Confirmation No. 3380
Examiner: Donald Champagne
MMB Docket No.: 1001-0821
NCR Docket No. 11447.10

TRANSMITTAL OF REPLY BRIEF

Please find for filing in connection with the above patent application the following documents:

1. Reply Brief (7 pages); and
2. One (1) return post card.

Commissioner for Patents

January 16, 2007

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Respectfully Submitted,

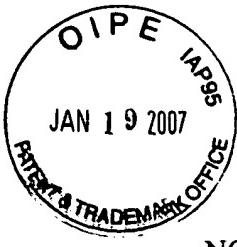
MAGINOT, MOORE & BECK



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Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

NCR Docket No. **11447.10**

MMB Docket No. **1001-0821**

Application of: **McGregor et al.**

Group Art Unit: **3622**

Serial No. **09/832,767**

Examiner: **Donald Champagne**

Filed: **April 11, 2001**

For: **SYSTEM FOR GENERATING REVENUE USING
ELECTRONIC MAIL AND METHOD FOR ITS USE**

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REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a reply submitted in response to the Examiner's Answer dated November 16, 2006.

Discussion

The discussion set forth in the Applicant's Appeal brief clearly and correctly identifies the relevance of the prior art cited by the Examiner as well as the Appellants' claims. The Examiner's response to the Appellants' arguments rests upon a misconstruction of the Appellants' claims. Moreover, the Examiner appears to have misunderstood the arguments set forth in the Appeal Brief.

1. Claim 14 is a Method Claim

The Examiner has argued that the rejection of claim 14 was misunderstood by the Appellants because "the electronic stamp is "software means" that meets the limitations of the claim." (Examiner's Answer at page 5). The Examiner's argument reveals a continued misconstruction of the claim and a misunderstanding of the arguments set forth in the Appeal Brief.

Specifically, the Examiner argues that because a link is "software means" the link of U.S. Patent Publication No. 20010025254 of Park (hereinafter "Park") "meets the limitation of the claim." (Examiner's Answer at page 5). Claim 14, however, recites "[a] method for generating revenue using electronic mail, comprising the steps of..." Thus, the mere existence of software in the system of Park is sufficient evidence of anticipation unless the software inherently performs the steps recited. The Examiner has not made an inherency argument and the Appellants are not aware of any reasonable basis for a finding that the software of Park inherently performs the steps recited.

Thus, the salient issue is whether or not Park discloses the *steps* recited in the claims. The Federal Circuit has held that a claim construction which did not require steps

to be performed in a particular order is foreclosed when, “as a matter of grammar,” a particular order is required by the language used in the claim. *Combined Systems, Inc. v. Defense Technology Corp.*, 68 USPQ2d , 1933, 1937 (Fed. Cir. 2003). Claim 14 recites “appending advertisement retrieval software means to the e-mail message *transmitted* from the first client computer.” The word “transmitted” is the past tense form of the verb “transmit.” Therefore, under normally accepted grammatical rules, the step of “appending” is performed on an e-mail that has already been transmitted. Thus, the “appending” is required to be performed *after* the step of transmitting.

Therefore, construction of claim 14 to include the appending of an e-mail *before* the e-mail is transmitted, as espoused by the Examiner, is foreclosed. Accordingly, the rejection of the claims is based upon a misconstruction of the claims. Therefore, as further discussed in the Appeal Brief, the rejection of the Appellants’ claims based upon the Examiner’s construction encompassing the appending of an e-mail before the e-mail has been transmitted should be reversed.

2. The Examiner Has Misconstrued Claims 15 and 25

The Appellants’ argued that the “e-mail user is the e-mail *sender* while the “e-mail recipient” is the e-mail *receiver*. Accordingly, because the advertisement content of Park is based upon receiver information, Park does not disclose appending advertisement retrieval software based upon sender information.” (Appeal Brief at page 6, emphasis in the original). To which the Examiner now states “[o]f course not, because there is no such limitation in the claims. The claims are limited to user information. There is no

limitation to “sender” information.” (Examiner’s Answer at page 6, emphasis in the original).

Since the Appellants never argued that the words “e-mail sender” appeared in the claims, the intended meaning of the Examiner’s assertions are confusing. It is possible that for the first time the Examiner intends to raise an argument that Park anticipates claims 15 and 25 because the “e-mail user” recited in the Appellants’ claims is an “e-mail recipient.” (Examiner’s Answer at page 6). To the extent that this is the intent of the Examiner, the Examiner has misconstrued the claims.

The Federal Circuit has stated that “[a]lthough the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1356, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999), citing *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Additionally, “the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2D 1321, 1326 (Fed. Cir. 2005).

Claim 15 depends from claim 14 which recites “wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body.” Therefore, the actual language of the claims indicate a difference between the terms “e-mail user” and “e-mail recipient.” The remaining claims provide additional insight. For example, claim 21 recites “composing an e-mail on a first client computer” and “sending the e-mail to a recipient. Additionally, claim 25, which is

argued together with claim 15, depends from claim 21 and adds “determining profile information regarding an e-mail account used to compose the e-mail.” Thus, the claims do not provide support for a construction wherein the “e-mail user” is the recipient of the e-mail. Rather, the claims provide support for a construction wherein the “e-mail user” is the composer of the e-mail, or, as argued in the Appeal Brief, the “e-mail sender” in contrast to an “e-mail recipient.”

The specification provides additional support for the construction of the “e-mail user” as the author of the e-mail. At page 9, lines 9-11, the Appellants’ specification states “after the email user is satisfied with the content and the address of the e-mail message, the e-mail user causes the e-mail message to be sent to each e-mail recipient.” This is repeated at page 9, lines 21-23 of the Appellant’s specification with reference to an alternative embodiment.

Additionally, establishment of the “e-mail user” account is discussed with reference to FIGs. 3 and 4 at page 12, line 24 through page 16, line 4 of Appellants’ specification. That passage states that “[u]pon receipt of the electronic form comprising the e-mail user data, host server 12 establishes a record in database 16 comprising the e-mail user data.” (Appellants’ specification at page 13, lines 11-13).

The foregoing “e-mail user” is the “e-mail user” which is thereafter referred to with respect to the discussion of FIG. 7A which states “the e-mail user composes e-mail messages, such as at block 73 of FIG. 7A.” (Appellants’ specification at page 24, lines 23-24). The message is described as including a header with the “e-mail address of the e-mail user, the e-mail address of at least one e-mail recipient, and the subject of the message.” Appellants’ specification at page 24, line 24 through page 25, line 1.

The Appellants' specification further discloses that “[i]n FIG. 10, at block 101, the advertisement processing software means reads the e-mail address of the e-mail user sending the e-mail message. At block 102, the advertisement processing software means uses the e-mail address to retrieve profile information about the e-mail user from database 16. At block 103 of FIG. 10, the advertisement processing software means compares the e-mail user's retrieved profile information against the target characteristics associated with the advertisements stored in database 16.” (Appellants' specification at page 25, lines 18-25). Thus, the specification consistently distinguishes between the “e-mail user” as the originator and sender of the particular e-mail and the recipient of the e-mail.

Therefore, in view of the claims and the specification, one of ordinary skill in the art would construe the “e-mail user” as set forth in the claims to be the originator or “sender” of the e-mail while the “e-mail recipient” is the recipient of the e-mail. Thus, while the Examiner properly noted that the claims recite “e-mail user” not “e-mail sender”, a proper construction of the term “e-mail user” as used in the claims is “the originator and sender of the e-mail.” Accordingly, as used in the claims, an “e-mail user” is not the “e-mail recipient.”

Conclusion

For the reasons set forth above and for all of the reasons set forth in the Applicants' Appeal Brief, claims 14, 15, 17-19, 21-22, 24-25 and 27 are not anticipated by Park and claim 23 is not obvious over Park. Accordingly, the Board of Appeals is respectfully requested to reverse the rejections of claims 14, 15, 17-19, 21-25 and 27.

Respectfully submitted,

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